



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,658	01/29/2004	Masaki Okamoto	36409	5389
116 7590 08/10/2007 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER PATEL, SHAMBHAVI K	
			ART UNIT 2128	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,658	Applicant(s) OKAMOTO ET AL.	
	Examiner Shambhavi Patel	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 33 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 April 2007 has been entered.
2. Claims 1-19 have been presented for examination.

Response to Arguments

3. Applicant's arguments filed 20 April 2007 have been fully considered but they are not persuasive.

Regarding the 35 U.S.C. 101 rejection:

- i. Applicant submits, on pages 9-10 of the remarks, "The Examiner contends...the subject claims are not patentable subject matter. Applicants respectfully disagree for at least the following reasons. Contrary to the Examiner's contentions, the Federal Circuit in *Eolas Technologies Inc. v. Microsoft Corp.* held that software alone constitutes patentable subject matter".

Examiner notes that the 101 rejection made was not because the claim did not fall into one of the four statutory categories. The rejection was made because the claims do not produce a tangible result. The claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for a second simulation result. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Art Unit: 2128

Regarding the 35 U.S.C. 102 rejections:

- ii. **Applicant submits**, on pages 10-11 of the remarks, that Sarvar does not disclose executing a simulation of the second step based on a second condition comprising the simulation condition and at least a third condition that yields a second simulation result because “Sarvar et al. teaches simulating peak temperature based on specific heat data which is empirically derived.”

Examiner notes that the specific heat data is not empirically derived; rather, it is calculated from empirically derived data. Sarvar discloses directly measuring the heat flow from material samples. The heat capacity may be calculated (i.e. simulated) by monitoring the heat flow. Thus, the simulated heat capacity is used to simulate the peak temperature.

- iii. **Applicant submits**, on page 11 of the remarks, that Sarvar does not disclose the limitation “...from the condition table and a condition input from the inputting portion” because “Sarvar et al. related to empirically deriving varying specific heat capacity values and then simulating a peak temperature.”

Examiner notes, that the specific heat data is not empirically derived; rather, it is calculated from empirically derived data. Sarvar discloses directly measuring the heat flow from material samples. The heat capacity may be calculated (i.e. simulated) by monitoring the heat flow. Thus, the simulated heat capacity is used to simulate the peak temperature.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-12 and 14-18 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. See MPEP Section 2106 which recites:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.

Art Unit: 2128

However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also *Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.”

Claim 1 is directed to a mounting process simulation program. **Claim 14** is directed to a mounting process simulation method of executing a simulation of a mounting process composed of a plurality of steps. The claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for a second simulation result. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2128

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarvar et al. ('Effective Modeling of the Reflow Soldering Process: Basis, Construction, and Operation of a Process Model'), herein referred to as Sarvar.**

Regarding claims 1 and 14:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium of causing a computer to execute a simulation of a mounting process composed of a plurality of steps, and a method of executing a simulation, comprising:

- a. a first simulation executing step of executing a simulation (**IV.B: specific heat capacity calculated (i.e. simulated)**) based on a first condition selected for a first step (**IV.B: heat flow**).
- b. a simulation condition deciding step of selecting a simulated result from the first simulation executing step as a simulation condition for a second step positioned subsequent to the first step (**Table III; 'Modeling of an Exemplar Product and Process Combination'**). The specific heat capacity is varied, and this value is used to calculate the peak temperatures.
- c. a second simulation executing step of executing a simulation-of the second step based on a second condition containing at least the simulation condition and a third condition

(Table III). The second condition, *specific heat capacity*, is simulated to obtain the peak temperature. Sarvar does not explicitly disclose a third condition. However, the simulation would obviously include properties of the materials being simulated, which are interpreted to be analogous to the third condition of the claim.

Regarding claim 2:

Sarvar discloses simulating a typical reflow profile (page 128 'Radiative Heating'). The temperature is varied with time (*conditions*), and this data is used to calculate the output. Therefore, the output (*analysis data*) is calculated during *each* temperature variation. The Examiner interprets 'analysis result data' to be data produced in the first simulation step that is then analyzed and/or sampled in the second simulation step, and 'wherein analysis result data simulated previously based on a plurality of conditions are generated every step' to mean that this data is produced at every step.

Regarding claim 3:

Sarvar discloses varying the specific heat capacity to record the temperature changes (page 131 'Modeling Variable Materials Data' paragraphs 1-3). The variable behavior of the specific heat capacity is represented in the models using *interpolation tables for each variable material*. Sarvar discloses simulating a typical reflow profile (page 128 'Radiative Heating'). The temperature is varied with time (*conditions*), and this data is used to calculate the output. Therefore, the output (*analysis data*) is calculated during *each* temperature variation. The Examiner interprets 'analysis result data' to be any data produced in the first simulation step that is then analyzed and/or sampled in the second simulation step, and 'wherein analysis result data simulated previously based on a plurality of conditions are generated every step' to mean that this data is produced at every step.

Art Unit: 2128

Regarding claim 4:

Sarvar discloses deriving the specific heat capacity by using the heat flow from samples analyzed with a calibrated Mettler TA3000 differential scanning calorimeter (**page 129 ‘Specific Heat Capacity Values’ paragraph 1**). This is analogous to the outside device in the claim language. The derived value is then converted to a computed-readable value and used in the simulation (**page 132 ‘Modeling of an Exemplar Product and Process Combination’ paragraph 1**). **Sarvar discloses** simulating a typical reflow profile (**page 128 ‘Radiative Heating’**). The temperature is varied with time (*conditions*), and this data is used to calculate the output. Therefore, the output (*analysis data*) is calculated during *each* temperature variation. The Examiner interprets ‘analysis result data’ to be any data produced in the first simulation step that is then analyzed and/or sampled in the second simulation step.

Regarding claim 5:

Sarvar discloses the simulation program of claim 4 wherein the experimental data simulated at every step via a CAE tool is selected as the analysis result data (**page 127 ‘Outline of System Components’ 2nd paragraph; page 129 ‘Specific Heat Capacity Values’ paragraph 1**), wherein the type of data selected as the analysis result data is converted to a common format (**figure 1 post processing and data presentation**). The specific heat capacity is experimentally derived and is then used in the simulation as the analysis result data to calculate its effect on the temperature variation (**page 132 ‘Modeling of an Exemplar Product and Process Combination’ paragraph 1**).

Regarding claim 6:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, further causing the computer to execute an animation displaying step of

Art Unit: 2128

displaying three-dimensionally an animation to indicate a result simulated in the second simulation executing step on a display device, by reading previously- stored animation elements based on a definition file in which an operation sequence is defined every step (**figure 8; page 132 'Modeling of an Exemplar Product and Process Combination' paragraph 1**).

Regarding claim 7:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, wherein the second simulation executing step includes a condition acquiring step of reading a condition selected in response to an input from a condition database in which a plurality of conditions are stored previously in combination, and adding the condition to the second condition (**page 131 'Modeling Variable Materials Data' paragraph 3**). The specific heat capacity is modeled using tables.

Regarding claim 8:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 7, wherein the condition acquiring step further reads data from a CAD system in response to the input and adds the data to the second condition (**figure 1**).

Regarding claim 9:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, wherein the first simulation executing step executes the simulation to contain production variation in the first step (**Table III: production variation specific heat capacity**), the simulation condition deciding step decides the result simulated in the first simulation executing step to contain the production variation as the simulation condition and the second simulation executing step

Art Unit: 2128

executes the simulation of the second step based on the second condition to contain the production variation (**Table III: simulation to determine variation in temperature due to variation in specific heat capacity**).

Regarding claim 10:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, wherein the first simulation executing step executes the simulation based on a change of a control item set in the first step as the first condition (**IV.B first condition is heat flow**), the simulation condition deciding step decides the result simulated based on the change of the control item in the first simulation executing step as the simulation condition (**IV.B first simulation calculated specific heat capacities**), and the second simulation executing step executes the simulation of the second step based on the second condition to contain the result simulated based on at least the change of the control item (**Table III: simulation to determine variation in temperature due to variation in specific heat capacity**).

Regarding claim 11:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, further causing the computer to execute a reliability evaluating step of executing a reliability evaluation of a product manufactured in the mounting process by using the result simulated in the second simulation executing step (**figure 6**).

Regarding claim 12:

Sarvar discloses a mounting process simulation program recorded on a computer-readable medium according to claim 1, further causing the computer to execute a fraction defective calculating step

Art Unit: 2128

of calculating a fraction defective of a product manufactured in the first step and the second step, by using results simulated in the first simulation executing step and the second simulation executing step

(Introduction: paragraphs 2 and 3).

Regarding claims 15 and 17:

Sarvar discloses selecting the first, second, and third condition from a plurality of conditions (section IV.B; table III). The plurality of conditions include the specific heat capacities, the heat flow, and the material properties.

Regarding claims 16 and 18:

Sarvar discloses the program of claim 15 wherein the plurality of conditions include part conditions (section IV.B heat flow).

Regarding claim 19:

Sarvar discloses displaying the results (figures 4 and 5). Sarvar does not explicitly disclose a 3D animation of the results. A skilled artisan would obviously have included this functionality because its results in a more user-friendly presentation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2128

6. **Claim 13 is rejected under 35 U.S.C. 102(b)** as being clearly anticipated by Sarvar et al. (**‘Effective Modeling of the Reflow Soldering Process: Basis, Construction, and Operation of a Process Model’**), herein referred to as Sarvar.

Regarding claim 13:

Sarvar discloses a mounting process simulation system provided to steps of a mounting process composed of a plurality of steps to execute a simulation of the mounting process, comprising:

- a. an inputting portion for inputting a plurality of conditions to execute the simulation (**figure 1; IV.B; table III: heat flow, specific heat capacity**)
- b. an executing portion for executing the simulation based on the condition input from the inputting portion (**figure 1**)
- c. an outputting portion for outputting a result of the simulation executed by the executing portion (**figure 1**)
- d. wherein the executing portion includes:
 - i. a condition table forming portion that forms a condition table of a second step positioned subsequently to a first step, whereby the condition table is formed by using a simulation result simulated based on a first condition selected for at least a first step, of a second step positioned subsequently to a first step (**IV.B: first condition is heat flow and first simulated result is specific heat capacities**) The specific heat capacities is modeled using an *interpolation table*. The first step is varying the heat capacity, and the second step is measuring the temperature.
 - ii. simulation result outputting portion executes the simulation of the second step based on the condition data from the condition table and a condition

Art Unit: 2128

input from the inputting portion and outputs a result to the outputting portion

(page 131 'Modeling Variable Materials Data' paragraphs 1-3). The

variation of the temperature is calculated based on this first condition.

Conclusion

7. **Examiner's Remarks:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shambhavi Patel whose telephone number is (571) 272-5877. The examiner can normally be reached on Monday-Friday, 8:00 am – 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571) 272-2279. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Application/Control Number: 10/767,658

Page 14

Art Unit: 2128

SKP

Shambhavi Patel
Examiner
Art Unit 2128


FRED FERRIS
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100